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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Philip W. Gillis	Conf.:	7281
Appl. No.:	09/316,040	Group:	2122
Filed:	May 21, 1999	Examiner:	Das, Chameli
For:	SYSTEM AND METHOD FOR GENERATING SOFTWARE TOOLS		

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This is an Appeal to the Examiner's Final Rejection of claims 1-15, 17-54, 57-65, which appear in the attached Appendix A.

1) **Real Party of Interest**

This application is assigned to LUCENT TECHNOLOGIES of Murray Hill, New Jersey by an Assignment recorded on May 21, 1999 at Reel 009981, Frames 0193.

2) **Related Appeals and Interferences**

The undersigned, the Assignee and appellants do not know of any appeals or interferences which would directly effect or be directly effected by or have a bearing on the Board's decision in this Appeal.

3) **Status of the Claims**

Claims 1-15, 17-54, 57-65 are reproduced in the attached Appendix A and are the claims on Appeal. Claims 16, 55 and 56 have been cancelled during prosecution of the application.

4) Status of the Amendments

A Reply Under 37 C.F.R. 1.116 was filed on July 16, 2003 (and resubmitted on August 25, 2003) in response to the Final Rejection of March 25, 2003. Only arguments were provided with no amendments. The Examiner, in an Advisory Action dated November 25, 2003, stated that the arguments were not persuasive, but did not indicate whether or not the Reply would be entered. Since no amendments were made, it is presumed that the Reply will be entered upon the filing of the Notice of Appeal and Appeal Brief.

5) Summary of the Invention

The present invention is directed to a method and apparatus for creating a software tool, such as a Wizard, to enable a user to easily create a customized tool for performing a specific task, without the need of complex programming, and to enable a user to create a tool which is easily modifiable to meet specific needs. Such a created tool can be one used to simplify a complex document, or to methodically step a user through the creation of an often used document, for example. Thus, unlike known Wizards which are complex to program and which are preprogrammed and non-modifiable, the software tool creation method and apparatus of the present invention enables one to easily create new software tools for any procedure or situation, and further enables the creation of tools which are easily modifiable to provide for the utmost flexibility.

The software tool creation method and apparatus of the present invention is preferably implemented in an apparatus 30, for example, including a CPU 32 operably connected to a memory 34 and an interface 36, and optionally connected, through a second machine interface 38, to any external machine.

The memory 34 stores the software tool creating method or program, the contents of which will be described in more detail with regard to the software tool creator or Wizard builder of Fig. 3. The memory 34 can optionally store a relational data base from which a software tool can be created, including a state table such as shown in Fig. 5 and a state transition table shown in Fig. 6.

A state is essentially a step in a procedure, with a state table being a table of a plurality of states in a procedure and corresponding attributes for each state. A state transition table is one that defines movements from state to state in response to a given input. Thus, in response to an answer selected, the state transition table defines a next-state in a procedure, and additional attributes.

The interface 36 can be in the form of an integrated input and display apparatus such as a touch screen, for example, or can include separate input and output interfaces such as a display (output) and a keyboard and/or mouse (input). Alternatively, or in addition, the inputting and outputting of information can be done audibly through a microphone (input) and speaker (output) wherein questions and choices of a created software tool, or prompts for creating a software tool, are audibly output to a user. Accordingly, the interface for inputting and outputting information to and from the CPU 32 can encompass known input and output devices.

Machine interface 38 provides access to an external machine. Thus, the software tool creator of the present invention can implement a software tool including process steps requiring information from an external machine, such as a computer. In the created software tool, the external machine may be designated to provide information in various steps of the created software tool.

For example, a software tool can be created by the apparatus and method of the present invention, which requires data from an external machine. This can be implemented in a process step. In creating the process step, the step is designatable as either a human type or machine type, with the machine type requiring use of a machine interface 38.

A software tool which has been created to implement a machine step may display something to a user during that step, but will not require a user selection. Instead, the machine interface 38 will contact an external machine, provide the external machine with a request for information, and await receipt of the information from the machine. Upon receiving such information, the created software tool then proceeds to the next step, either requiring more machine information or requiring input from a user. Such a machine interface 38, for example, can include a URL address, accessing a particular computer website on the worldwide web, for example, and thus requesting receipt of information external to the apparatus 30.

Fig. 3 illustrates an apparatus for creating a software tool, such as a Wizard, which has been designated Wizard builder 100. The Wizard builder 100 shown in Fig. 3 is implemented in the form of a display requesting input of information, through a keyboard for example, to create a software tool. Fig. 4 illustrates a screenshot corresponding to the information input to Wizard builder 100 of Fig. 3, the screenshot being a screen of a software tool created by the Wizard builder 100 of Fig. 3.

Wizard builder 100 of Fig.. 3 includes a first predetermined section 102, corresponding to "state". A "state" corresponds to a step in a process. Accordingly, a user is prompted to input a process step in a first window 104. In the example shown in Fig. 3, the state "2", corresponding to second step in a process, is input into the window 104.

Next, "procedure" 106 is displayed by the Wizard builder 100, prompting input of the procedure title or process to be implemented by the Wizard builder 100, in a second window 108. This procedure 106 will not normally change as the various states change (although a software tool can be created which takes a user through multiple linked procedures), and is an indication of what is being implemented by the Wizard builder 100, namely what is the title of the software tool.

6) Issues

i) Whether or not claims 1-2, 4-15, 17, 19-22, 26-34, 36-37, 39-43, 48, 50-54, 57, 59, 61, and 65 are unobvious under 35 U.S.C. § 103(a) in view of the teachings of Tidwell (U.S. Patent 5, 859,637) in view of Linnett et al. (U.S. Patent No. 5,301,326); and whether or not the reference combination is proper.

ii) Whether or not claims 63-64 are obvious under 35 U.S.C. §103(a) in view of the teachings of Tidwell in view of Linnett et al., and further in view of Batch et al. (U.S. Patent No. 5,423,023); and whether or not the reference combination is proper.

iii) Whether or not claims 3, 18, 23-25, 35, 38, 44-47, 49, 58, 60, and 62 are unobvious under 35 U.S.C. §103(a) in view of the teachings of Tidwell, in view of Linnett et al., and further in view of U.S. Patent 5,974,446 to Sonnenreich; and whether or not the reference combination is proper.

7) Grouping of the claims

Appellants respectfully request, for the purposes of this Appeal, that the grouping of the claims be as follows:

i) claims 1-2, 4-17, 19-22, 26-34, 36-37, 39-43, 57, 59, 61 and 65;

ii) claims 3, 18, 23-25, 35, 58, 60, 62;

iii) claim 63;

iv) claims 44-47 and 49;

v) claims 48 and 50-54; and

vi) claim 64

8) Arguments

8a) The Rejections

The Examiner has rejected claims 1-2, 4-15, 17, 19-22, 26-34, 36-37, 39-43, 48, 50-54, 57, 59, 61 and 65 under 35 U.S.C. 103 (a) as being unpatentable over Tidwell, II (Tidwell), U.S. Patent No. 5,859,637 in view of Linnett et al (Linnett), U.S. Patent No. 5,301,326.

The Examiner has rejected claims 63-64 under 35 U.S.C. 103 (a) as being unpatentable over Tidwell (US 5,859,637) and Linnett (US 5,301,326) and further in view of Batch et al (Batch), US 5,423,023.

The Examiner has rejected claims 3, 18, 23-25, 35, 38, 44-47, 49, 58, 60, 62 under 35 U.S.C. 103 (a) as being unpatentable over Tidwell, II (Tidwell) U.S. Patent No. 5,859,637 and Linnett et al (Linnett), U.S. Patent No. 5,301,326 and further in view of Sonnenreich et al (Sonnenreich), U.S. Patent No. 5,974,446.

8b) Teachings of the References

Tidwell teaches a method and apparatus to provide wizards using a script-like language that supports a predetermined set of commands. The commands are defined by a driver called the smart guide driver. The wizards, or smart guides as they are called when implemented using the script-like means, allow the user to customize the smart guides for their particular application using a standard text editor. Thus, the smart guide driver (207) executes on top of the operating

system (203) and interacts with the application program (205) to provide an interface to the application program (205). Tidwell; col. 4, lines 10-44. The smart guide script may allow modification of the smart guide driver (207), but it fails to solicit the input prompted by Appellant's claims 1, 20, and 36.

Linnett implements a user interface for one or more application programs. The interface program interacts between the user and an application program to perform specific tasks. Linnett; col. 3, lines 5-15. The inputs from the user, which are requested by the interface program, are used to generate task commands that are sent to the application computer program to run specific tasks. Linnett does not disclose any manner of building a wizard, but instead teaches a method of using a wizard to interface between a user and an application program.

Sonnenreich teaches a method of using the World Wide Web for distance learning. It includes an index of a plurality of different informational topics, a personal information of user database, a toolbar section to choose the topics, a message reader section to integrate email, a communications chatting dialog section and the list of all the users who have selected identical or similar topics. Thus, the components of Sonnenreich are integrated together to allow users in geographically separated areas to use the internet, a WAN or a LAN a single simulated classroom. The Sonnenreich patent does not teach, disclose or make obvious any method of wizard building.

Batch discloses a method where the input data and control inputs are simply values or parameters used in the execution of already defined software tools. Specifically, Batch requests "inputs when inputs to a software tool being executed are required" (column 8, lines **40-46).** Moreover, Batch requests "items which the user must add as inputs ... [and inhibits] further operation of the tool ... until the user makes such required inputs" (column 4, lines 61-64).

As such, the inputs of Batch are simply data or parameters required for the execution of an already defined software tool. Batch requests input of parameters and values for use in the execution of already defined process steps within an already defined software tool.

8c) Examiner's Rejections

Claims 1-2, 4-15, 17, 19-22, 26-34, 36-37, 39-43, 48, 50-54, 57, 59, 61 and 65 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Tidwell, II (Tidwell), U.S. Patent No. 5,859,637 in view of Linnett et al (Linnett), U.S. Patent No. 5,301,326.

The examiner asserts with respect to claim 1 that Tidwell discloses:

- a method for creating a wizard (column 2 line 48, "The present invention is a method for creating a wizards")

-prompting input (column 61ine 21-22,"programmable means for said SmartGuides to prompt said user for input")

- process steps and a plurality of potential selections associated with each of the process steps (column 41ine 18-59, "Here's an entry field ... The <dataentry> fields create boxes for the user to enter input to the application (409)"), if the user enters "name", there are several selections associated with the each input

- using the process steps and associated potential selections to create a wizard as claimed (column 2 line 48-60, "The present invention in a method for creating wizards using a script-like language that supports a predetermined set of commands ... user interface to the user") and (column 21ine 25-30, "It is an object of the invention to present an intuitive, easy to use method of creating wizards such that a person familiar with the user interface of the application program and able to understand a finite set of English-like commands is able to create the

wizard using this predetermined set of commands"), where the predetermined set of commands are process steps and associated potential selection.

The examiner admits Tidwell does not specifically disclose storing the input processes and output is based upon input selections.

However the examiner asserts Linnett discloses storing the input processes and output is based upon input selections (column 9 line 32-33, "collecting user input relating to the specialized task to be performed") and (column 9 line 36-38, "selecting commands to effect the performance of the specialized task by the application computer program based on the collected user input"), where collecting user input relating to the specialized task is considered as storing the input process and the performance of the socialized task is considered as the output which is based on the collected input. The specialized task is performed by the interface program which is a wizard is shown in (column 2 line 32-34, "It is another object of the present invention to provide an interface program that has expert knowledge relating to the performance of a specialized task") and (column 3 line 10-11, "An interface program is referred to as a wizard").

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Linnett into the method of Tidwell to store the input processes and create the output based upon the input. The modification would be obvious because one of the ordinary skill in the art would want to provide an efficient tool and allows third parties to extend and customize the feature of an existing application program (column 2 line 28-30).

The examiner asserts that claim 36 is a computer usable medium claim corresponding to the method claim 1 and rejected under the same reason set forth in connection of the rejection of claim 1.

The examiner asserts with respect to claims 2, 37 and 48, Tidwell discloses:

- prompting is performed by a displayed template (Figure 4A, 4B and 4C).

The examiner asserts with respect to claim 4, that Tidwell discloses:

- input of a designation is further prompted, associating a potential selection with a subsequent process steps (Fig 4B and Fig 4C), where for a input some potential selections are associated with these input which are displayed in the windows.

The examiner admits Tidwell does not specifically disclose storing the input processes. However, The examiner asserts Linnett discloses storing the input processes (column 9 line 32-33, "collecting user input relating to the specialized task to be performed"), where the specialized task is performed by the interface program which is a wizard (column 2 line 32-34) and, "(column 3 line 10-11).

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Linnett into the method of Tidwell to store the input processes. The examiner asserts the modification would be obvious because one of the ordinary skill in the art would want to provide an efficient wizard.

The examiner asserts with respect to claims 4, 26, 39 and 50, that Tidwell discloses:

- input of a designation is further prompted, associating a potential selection as claimed (column 41ine 10-60).

The examiner asserts with respect to claims 5 and 27, Tidwell discloses:

potential selections permits input of a character string (Fig. 4C), where the potential selection is "Vanilla", which is a character string.

The examiner asserts with respect to claim 6, Tidwell discloses:

- wherein the created wizard is displayed (column 5 line 37-39, " SmartGuide Driver presenting a graphical user interface to the user based on instructions within the SmartGuide Script"), where Smartguide is the wizard (column 21line 52-54, "The wizards, or SmartGuides as they are called when implemented using the script-like means of the present invention").

The examiner asserts with respect to claim 7 and 61, Tidwell discloses:

- wherein the created wizard is displayed as sequential process steps with potential selections (column 5 line 37-39) and Figure 4A, 4B and 4C.

The examiner asserts with respect to claim 8, Tidwell discloses:

- wherein each of the plurality of sequential steps in a process is displayed concurrent with a single step and associated potential selections (Fig 4A, 4B and 4C).

The examiner asserts with respect to claims 9, 10, 28, 29, 40, 41, 51 and 52, Tidwell discloses:

- query and potential answers are prompted (Fig 4B and 4C).

The examiner asserts with respect to claim 11 and 30, Tidwell does not specifically disclose storing the created wizard However, the examiner asserts Linnett discloses storing the created wizard (Figure 6 in 603 "Save previous pages"), where the page is a pagewizard (column 3 line 12-13, "several user interface programs, called PageWizards"). The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Linnett into the method of Tidwell to store

the created wizard. The examiner asserts the modification would be obvious because one of the ordinary skill in the art would allow the third parties to extend and customize the feature of an existing tool (stored wizard).

The examiner asserts with respect to claim 12 and 31, Tidwell discloses:

- wizard is modifiable (column 21ine 34-35, "It is yet another object of the present invention to enable users to modify a wizard").

The examiner asserts with respect to claim 13, 32, 42 and 53, Tidwell discloses:

- indicating one of machine and non-machine processing (column 5 line 26-27, "A method in a computer system for enabling a user to perform a task by a SmartGuide providing direction to an application program"), where " a method in a computer system for enabling a user" is considered as a machine process and (column 5 line 32-34, "SmartGuide Script created using a discrete number of English-readable commands to present information to the user"), where " English-readable commands" is considered as non-machine process.

The examiner asserts with respect to claim 14, 33, 34, 43, 54 and 59 Tidwell discloses:

- input of information relating to the machine processing is prompted (column 3 line 50-51, "SmartGuide scripts (209) are then created which execute in the memory") and (column 5 line 5-6, "FIG. 4C is a panel which presents the results of the information input to the SmartGuide by the user"), where Smartguide is the wizard, which is executing inherently including machine processing and prompting to the user.

The examiner asserts with respect to claim 15, Tidwell discloses:

- created wizard sequentially conveys each of input process steps and prompts selections of a potential selection (column 5 line 26-33).

The examiner asserts with respect to claim 17, Tidwell discloses:

- created wizard sequentially displays each of the input process steps (Fig 4A, 4B and 4C).

The examiner asserts with respect to claim 19, Tidwell discloses:

- wherein conveyance of a process step is dependent upon a selection made in response to a previously conveyed process step (Fig 4A, 4B and 4C), where <back> and <next> are considered as previous and next steps.

The examiner asserts with respect to claim 20, Tidwell discloses:

- A wizard creator (Abstract line 1-3, "A method and apparatus are provided whereby a person not familiar with programming or programming languages can create a wizard")

- a user interface (Abstract line 3-4, "to interface between an application program and the user")

- adapted to prompt input ofprocess steps (column 6 line 21-22, "programmable means for said SmartGuides to prompt said user for input")

- potential selections associated with each of the process steps (Fig 4A, 4B and 4C)

- a memory (column 3 line 50-51, "SmartGuide scripts (209) are then created which execute in the memory (201)")

- a processor (column 3 line 37-38, "computer system containing a display device, a processor and an input device")

- create a wizard (column 2 line 52-53, "The wizards or SmartGuides as they are called when implemented using the script-like means").

The examiner admits Tidwell does not specifically disclose storing the input processes and output is based upon input selections.

However, the examiner asserts Linnett discloses storing the input processes and created wizard is based upon input selections (column 91ine 32-33, "collecting user input relating to the specialized task to be performed") and (column 9 line 36-38, "selecting commands to effect the performance of the specialized task by the application computer program based on the collected user input"), where collecting user input relating to the specialized task is considered as storing the input process and the performance of the socialized task is considered as the output which is based on the collected input. The examiner asserts the specialized task is performed by the interface program which is a wizard is shown in (column 2 line 32-34, "It is another object of the present invention to provide an interface program that has expert knowledge relating to the performance of a specialized task") and (column 3 line 10-11, "An interface program is referred to as a wizard").

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Linnett into the method of Tidwell to store the input processes and create the output based upon the input. The examiner asserts the modification would be obvious because one of the ordinary skill in the art would want to provide an efficient tool and allows third parties to extend and customize the feature of an existing application program (column 21ine 28-30).

The examiner asserts with respect to claims 21, 22 Tidwell discloses:

- user interface and user interface is an integrated input and displayed (column 4 line 10-60).

The examiner asserts with respect to claim 57, Tidwell discloses:

- accessing prestored information and creating the wizard, at least in part, based upon the prestored information (column 2 line 62-67, "the SmartGuides of the present invention allow the user to customize the SmarGuide for their particular application .. modifying the

commands contained in the SmarGuide Script"), where modifying the commands contained in the Smartguide script" inherently including accessing prestored information for customizing the wizard.

The examiner asserts with respect to claim 65, Tidwell does not specifically disclose the plurality of languages. However, in backgroud of the invention discloses the plurality of languages (column 2 line 1215, "wizards are traditionally written in programming languages such as C or C++. Since the wizards are written in programming languages").

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of the background into the Tidwell to have a plurality of languages. The examiner asserts the modification would be obvious because one of the ordinary skill in the art would want to have different choices of language.

Claims 63-64 are rejected over Tidwell, II (Tidwell), US Patent No. 5,859,637 and Linnett et al (Linnett), U.S. Patent No. 5,301,326 and further in view of Batch et al (Batch), US Patent No. 5423,023.

The examiner admits with respect to claim 63 and 64, neither Tidwell nor Linnett specifically disclose:

- information are stored in a state transition table.

However, the examiner asserts Batch discloses the information are stored in a state transition table (column 4 line 67-68 and column 5 line 1-7).

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Batch into the combined method of Tidwell and Linnett to store the information in the state transition table. The examiner

asserts the modification would be obvious because one of the ordinary skill in the art would be motivated to store the information logically for operating and interacting the information with digital waveforms (column 5 line 1-10).

Claims 3, 18, 23-25, 35, 38, 44-47, 49, 58, 60, 62 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Tidwell, II (Tidwell) U.S. Patent No. 5,859,637 and Linnett et al (Linnett), U.S. Patent No. 5,301,326 and further in view of Sonnenreich et al (Sonnenreich), U.S. Patent No. 5,974,446.

The examiner admits with respect to claim 3, 18, 24, 25, 38 and 49, neither Tidwell nor Linnett disclose:

prompting is audible.

However, the examiner asserts with respect to Sonnenreich discloses the prompting is audible (column 4 line 48-50, "As the audio plays through there will be numerous images and interactive demonstration that will appear on the user's screen").

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Sonnenreich into the combined method of Tidwell and Linnett to have audible prompting for the user. The examiner asserts the modification would be obvious because one of the ordinary skill in the art would be motivated to produce a sound allowing a user to send or receive information efficiently.

The examiner admits with respect to claim 23, neither Tidwell nor Linnett disclose the user interface is a touch screen. However, the examiner asserts Sonnenreich discloses the touch screen (column 10 line 5-7, "the user is now ready to select (G) the topic (subject) of interest on the main screen by "pressing" the appropriate button (i.e. mouse or touch screen, etc.).

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Sonnenreich into the combined method of Tidwell and Linnett to have touch screen. The examiner asserts the modification would be obvious because one of the ordinary skill in the art would be motivated to provide a system where the user can make a selection of the icon easily.

The examiner admits with respect to claim 35 and 62 neither Tidwell nor Linnett disclose URL. However, Sonnenreich discloses URL (column 7 line 64, "Suitable types of the above are described in the following Web Page URL references:").

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Sonnenreich into the combined method of Tidwell and Linnett to includes input of a URL. The examiner asserts the modification would be obvious because one of the ordinary skill in the art would be motivated to locate a resource (such as a file) from anywhere in the Internet.

The examiner admits with respect to claim 44, neither Tidwell nor Linnett disclose propagated signal. However the examiner asserts Sonnenreich discloses propagated signal (column 3 line 10-11, "university link-ups with digital signal transmission are being tested").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Sonnenreich into the combined method of Tidwell and Linnett to propagate a signal. The modification would be obvious because one of the ordinary skill in the art would be motivated to transmit information to the user efficiently. For the rest of the limitations see the rejection of claim 1.

As per claim 45,46 and 47, neither Tidwell nor Linnett disclose propagated signal is digital bit stream and carrier wave. However Sonnenreich discloses propagated signal is

digital bit stream and carrier wave (column 3 line 10-11, "university link-ups with digital signal transmission are being tested").

The examiner concludes it would have been obvious to a person of ordinary skill in the art at the time of invention was made to incorporate the teaching of Sonnenreich into the combined method of Tidwell and Linnett to propagate a signal. The examiner asserts the modification would be obvious because one of the ordinary skill in the art would be motivated to transmit information to the user very distinctly and clearly.

The examiner admits with respect to claims 58 and 60, neither Tidwell nor Linnett disclose database. However, the examiner asserts Sonnenreich discloses data bases (column 6 line 65-67, "the user screen topic "buttons" are customized by the server to those topics of interest .selected by the user and stored in said database;"). The examiner admits Sonnenreich does not specifically disclose the database is relational. Official notice is taken in relational data base is well known in the art. The examiner asserts it would have been obvious to one of the ordinary skill in the art at the time of invention was made to make the data base relational because one of the ordinary skill in the art would be motivated to find information easily and efficiently.

8d) General Reasons Why Each of the Claims of the Application are Patentable Over the Prior Art Reference Combination

1. Lack of motivation and improper use of hindsight for combining the references

The Examiner must provide some teaching, suggestion or motivation to combine various aspects of the references. The Examiner is not entitled to randomly pick and choose portions of the references to reject Appellants' claims, without some teaching or suggestion to combine the references. An obviousness inquiry assesses "the differences between the subject matter sought

to be patented and the prior art" to ascertain whether "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains" 35 U.S.C. § 103(a)(1994). Obviousness requires a suggestion or motivation to modify one prior art teaching in view of another, to obtain the claimed invention. The inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole. As stated in *In re Rouffet,* 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added):

> This Court has explained the purpose of the motivation to combine requirement: to prevent the use of hindsight based on the invention to defeat the patentability of the invention, this Court requires the [challenger] to show a motivation to combine the references that create the case of obviousness. In other words, the [challenger] must show reasons that the skilled artesian, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the matter claimed.
>
> This Court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

Similar requirements were set forth in *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999).

Appellants submit that the Examiner has not properly met the motivation requirement. As stated in *Dembiczak*, in order to establish a *prima facia* case of obviousness under 35 U.S.C. § 103, the Examiner must provide particular findings as to why the two pieces of prior art are combinable, wherein broad conclusory statements standing alone are not "'evidence". *See Dembiczak*, 50 USPQ2d at 1670. Appellants believe that the Examiner has made only broad conclusory statements and has used only Appellants' invention in hindsight, as a blueprint to reject the claims.

The Examiner has not met the requirements set forth above and has merely picked and chosen portions of references. Any alleged motivation has essentially been derived solely from

Appellants' specification. Accordingly, no *prima facia* statement of obviousness has been made and thus withdrawal of all outstanding rejections in connection with the present application is respectfully requested.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a *convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972,973 (Bd. Pat. App. & Inter. 1985).

The Appellant respectfully contends; particularly in light of the substantial differences between creating a wizard script in the Tidwell patent and the use of a wizard as a user interface in the program of the Linnett patent, there is no motivation to combine the two patents. The present action fails to provide the required "convincing line of reasoning" as to how or why one of ordinary skill would be motivated to make the proposed combination in order to solve a problem not recognized by either the Linnett patent or the Tidwell patent. Thus, the Appellant respectfully submits that neither the Tidwell nor the Linnett patent provides proper motivation for combining one with the other.

The Examiner asserts it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Linnett into the method of Tidwell:

> "...to store the input processes and create the output based upon the input. The modification would be obvious because one of ordinary skill in the art would want to provide an efficient tool and allow third parties to extend and customize the features of an existing application program."

Appellants respectfully submit that the motivation relied upon by the Examiner is insufficient for one of ordinary skill in the art to combine Linnett with Tidwell. The Examiner's general assertion that third parties would want to extend and customize the features of an application program is insufficiently specific (i.e., too overly broad a conceptual statement) to direct one of ordinary skill in the art specifically toward Tidwell, over any other wizard-related teaching available at the time. The Examiner's alleged motivation is the possible outcome that would result from combining Tidwell and Linnett, not a reason why one of ordinary skill would combine Linnett and Tidwell. Using the Examiner's alleged motivation, one of ordinary skill in the art would be motivated to combine every wizard-related teaching in hopes that some improvement would be made. Appellant respectfully submits that the only hindsight would allow the combination of Linnett and Tidwell, and this is improper. Accordingly, Appellant respectfully requests reconsideration and withdrawal of this rejection for this reason.

The Appellant respectfully submits, in addition to a lack of motivation to combine the teachings of the Tidwell patent with that of the Linnett patent (previously discussed), there is a lack of motivation to combine the teachings of the Sonnenreich patent or the Batch patent. The Examiner has failed to support his conclusion of obviousness with a "convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference." *Ex parte Clapp*, 227 USPQ 972,973 (Bd. Pat. App. & Inter. 1985). The Appellant further submits that a desire for an inventor to want a bigger, better, or more "efficient" invention does not satisfy the convincing line of reasoning requirement; nor does it necessarily place such combinational teachings within the skills of the ordinary artisan.

Additionally, picking and choosing portions of references, without considering the references as a whole for what they reasonably teach, is impermissible.

In Panduit Corp. v. Dennison Manufacturing Co., 227 U.S.P.Q. 337, 344 (Fed. Cir. 1985), *vacated and remanded on other grounds*, 229 U.S.P.Q. 478 (1986) the Federal Circuit stated:

> The well established rule of law is that each prior art reference must be evaluated as an entirety, and that all of the prior art must be evaluated as a whole. *See W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 727 F.2d at 1550, 220 U.S.P.Q. at 311; *In re Kuderna*, 426 F.2d 385, 290, 165 U.S.P.Q. 575, 578-79 (CCPA 1970).

And, in Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986), the Federal Circuit stated:

> As the former Court of Customs and Patent Appeals held:
> It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA 1965); *see also In re Mercer*, 515 F.2d 1161, 1165-66, 185 U.S.P.Q. 774, 778 (CCPA 1975).

As demonstrated above, the Federal Circuit has directed that prior art references must be considered as whole and that it is impermissible for the Examiner to pick and choose only so much of the reference as to support the Examiner's position and ignore other teachings necessary for a full appreciation of what the reference suggests.

As a whole, the Tidwell patent teaches a basic method of wizard building. The Linnett patent merely discloses the way a wizard may be used as an interface between an application program and a user. Finally, the unrelated Sonnenreich patent discloses a method of joining geographically diverse users in a single electronic classroom setting. Thus, as stated by the Federal Circuit, it is impermissible for the Examiner to pick and choose only portions of the cited art to reconstruct the Appellant's claims. Therefore, Appellants respectfully request that the rejection of these claims under 35 U.S.C. § 103 is an error and should be reversed.

8e) . Further Reasons Supporting the Allowability of Group I Including Claims 1-2, 4-17, 19-22, 26-34, 36-37, 39-43, 57, 59, 61 and 65

In the Office Action mailed March 25, 2003, the Examiner asserts "...it would have been obvious to a person of ordinary skill art at the time that the invention was made to incorporate the teachings of Linnett into the method of Tidwell to store the input processes and create the output based upon the input. The modification would be obvious because one of ordinary skill in the art would want to provide an efficient tool and allow third parties to extend and customize the features of an existing application program..."

As support for the above-mentioned motivation, the Examiner relies on column 2, lines 28-30 of Linnett which states "it is another object of the present invention to provide an interface program that has expert knowledge relating to the performance of a specialized task." However, Appellant respectfully asserts that this portion of Linnett does not contemplate a wizard builder. In fact, the concept of a wizard builder is not contemplated anywhere in the Linnett patent. Accordingly, Appellant respectfully submits that the Examiner has failed to establish motivation for why one of ordinary skill in the art would apply the Linnett interface teachings to a wizard builder scenario, such as the wizard builder scenario set forth in Tidwell. Linnett does not even recognize the existence of a wizard builder, let alone suggest that the Linnett interface could be used for such a task. Accordingly, Appellant respectfully submits that there is no motivation for combining Linnett with Tidwell, and the Examiner's rejection under 35 U.S.C. §103(a) must fail for at least this reason.

Appellant further respectively submits that Tidwell makes no mention of the need for or desirability of an interface program, such as the interface program disclosed in Linnett. Accordingly, Appellant respectfully submits that Tidwell also fails to provide sufficient motivation for combination with Linnett. Accordingly, since Linnett does not provide

motivation for combination with Tidwell and vice versa, Appellant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) is improper.

Appellant further respectfully submits that both references, even if combinable, fail to teach or suggest prompting both the input of process steps and associated selections, and using those to create a wizard, as set forth for example, in independent claim 1 of the present application.

Finally, the Examiner improperly makes the assumption that the term "collecting," found in the Linnett patent, is meant to mean storing as found in claim 1 of the Appellant's claims. In doing so, the Examiner states "where collecting user input relating to the specialized task is considered as storing the input process... ." However, storage means cannot be injected into the Linnett patent, where the Linnett patent does not teach or disclose storage means. It appears that claim 8, cited by the Examiner, takes the collected user input to immediately effect the application computer program. Thus, it is improper for the Examiner to infer that a storage function is taking place; particularly when no such storage means is recited in the Linnett patent.

Thus, although Appellants strongly believe that there is no reason to combine the teachings of Tidwell. and Linnett, even assuming *arguendo* that they could be combined, it is respectfully submitted that the subject matter of independent claims 1, 20, and 36 is clearly unobvious in view of the combination of references. Appellants respectfully assert dependent claims 2, 4-17, 19, 21-22, 26-34, 37, 39-43, 57, 59, 61 and 65 are allowable by virtue of their dependency on allowable independent claims 1, 20, or 36 for at least the reasons set forth above. Therefore, Appellants respectfully request that the rejection of these claims under 35 U.S.C. § 103 is an error and should be reversed.

8f) Further Reasons Supporting the Allowability of Group II, Including Claims 3, 18, 23-25, 35, 58, 60, 62

For reasons similar to the reasons set forth above with respect to Tidwell and Linnett, Appellnayts further respectively submits that Sonnereich provides absolutely no motivation for combination with Tidwell/Linnett and vice versa. Accordingly, since Sonnereich does not provide motivation for combination with Tidwell/Linnett and vice versa, Appellant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) is improper.

8g) Further Reasons Supporting the Allowability of Group III, Including Claim 63

For reasons similar to the reasons set forth above with respect to Tidwell and Linnett, Appellnayts further respectively submits that Batch provides absolutely no motivation for combination with Tidwell/Linnett and vice versa. Accordingly, since Batch does not provide motivation for combination with Tidwell/Linnett and vice versa, Appellant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) is improper.

8h) Further Reasons Supporting the Allowability of Group IV, Including Claims 44-47 and 49

The Examiner claims that the rejection of claim 1 with respect to the Tidwell patent and the Linnett patent are applicable to claim 44. However, the Examiner also asserts that the Sonnenreich patent discloses the propagated signal not disclosed by either the Tidwell or the Linnett patent. As detailed herein with respect to claim 1, the Tidwell patent in view of the Linnett patent, fail to disclose or make obvious claim 1. Similarly, the Tidwell patent in view of the Linnett patent, further in view of the Sonnenreich patent, fails to disclose, teach or make obvious Appellant's claim 44.

Just as the Tidwell patent in view of the Linnett patent fails to disclose "prompting input of process steps and a plurality of potential selections associated with each of the process steps," "storage of input process steps and associated potential selection," and "creation of a wizard based upon stored process steps and associated potential selection," as taught by Appellant's claim 44; a cursory review of the Sonnenreich patent reveals that the Sonnenreich patent fails to overcome the disclosure and suggestion deficiencies of the Tidwell patent in view of the Linnett patent.

For at least the above reasons, the Appellant submits that claim 44 is allowable. Appellants respectfully assert dependent claims 45-47 and 49 are allowable by virtue of their dependency on allowable independent claim 44 for at least the reasons set forth above. Therefore, Appellants respectfully request that the rejection of these claims under 35 U.S.C. § 103 is an error and should be reversed.

8i) Further Reasons Supporting the Allowability of Group V, Including Claims 48 and 50-54

Claims 48 and 50-54 are dependent upon independent claim 44. The examiner's rejection of claim 44 requires Sonnenreich, but the rejection of claims 48 and 50-54 does not. Appellants assert that this rejection is deficient on its face. Therefore, Appellants respectfully request that the rejection of these claims under 35 U.S.C. § 103 is an error and should be reversed.

8j) Further Reasons Supporting the Allowability of Group VI, Including Claim 64

Claim 64 is dependent upon dependent claim 4604. The examiner's rejection of claim 60 requires Sonnenreich, but the rejection of claim 64 does not. Appellants assert that this rejection

is deficient on its face. Therefore, Appellants respectfully request that the rejection of this claim under 35 U.S.C. § 103 is an error and should be reversed.

CONCLUSION

It is respectfully submitted that the rejections of each of pending claims 1-15, 17-54 and 57-65 under 35 U.S.C. § 103 as being unpatentable over Tidwell in view of Linnett et al., or in view of the aforementioned combination and further in view of Batch or Sonmenridea, is in error and should be reversed. At best, the Examiner has found bits and pieces of Appellants' invention and has randomly combined various teachings of prior art references without proper motivation and based solely upon Appellants' own disclosure. Accordingly, for at least the aforementioned reasons, Appellants respectfully request the Honorable Members of the Board of Patent Appeals and Interferences to reverse each of the outstanding rejections in connection with the present application and allow each of claims 1-15, 17-54, and 57-65 to be allowed in connection with the present application.

This Appeal Brief is being presented in triplicate.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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APPENDIX A

The claims on Appeal in U.S. Serial No. 09/316,040 are claims 1-15, 17-54, and 57-65, which are presented hereinbelow.

1. A method for creating a wizard, comprising:

prompting input of process steps and a plurality of potential selections associated with each of the process steps;

storing input process steps and associated potential selections; and

using the stored process steps and associated potential selections to create a wizard for outputting the input process steps based upon input selections.

2. The method of claim 1, wherein the prompting is performed by a displayed template.

3. The method of claim 1, wherein the prompting is audible.

4. The method of claim 1, wherein input of a designation is further prompted and stored, associating a potential selection with a subsequent process step.

5. The method of claim 1, wherein one of the potential selections permits input of a character string.

6. The method of claim 1, wherein the created wizard is displayed.

7. The method of claim 6, wherein the created wizard is displayed as sequential process steps with potential selections.

8. The method of claim 7, wherein each of the plurality of sequential steps in a process is displayed concurrent with a single step and associated potential selections.

9. The method of claim 1, wherein input of a query is prompted as a process step.

10. The method of claim 9, wherein potential answers to the query are prompted as associated potential selections.

11. The method of claim 1, further comprising storing the created wizard.

12. The method of claim 11, wherein at least one of a stored process step and potential selection in the created wizard is modifiable.

13. The method of claim 1, further comprising prompting and storing input of a designation, associated with a process step, indicating one of machine and non-machine processing.

14. The method of claim 13, wherein upon receiving an input designation indicating machine processing, further input of information relating to the machine processing is prompted.

15. The method of claim 1, wherein the created wizard sequentially conveys each of the input process steps and prompts selection of a potential selection for each process step.

16. **(Cancelled)**

17. The method of claim 15, wherein the created wizard sequentially displays each of the input process steps.

18. The method of claim 15, wherein the created wizard audibly sequentially outputs each of the input process steps.

19. The method of claim 15, wherein conveyance of a process step is dependent upon a selection made in response to a previously conveyed process step.

20. A wizard creator, comprising:

a user interface, adapted to prompt input of process steps and potential selections associated with each of the process steps;

a memory adapted to store input process steps and associated potential selections; and

a processor, adapted to create a wizard based upon the stored process steps and associated potential selections.

21. The wizard creator of claim 20, wherein the user interface is displayed.

22. (The wizard creator of claim 21, wherein the user interface is an integrated input and display.

23. The wizard creator of claim 21, wherein the user interface is a touch-screen.

24. The wizard creator of claim 20, wherein the user interface prompts audibly.

25. The wizard creator of claim 21, wherein the memory is adapted to store audibly input process steps and associated potential selections.

26. The wizard creator of claim 20, wherein the user interface is further adapted to prompt input of a designation, associating a potential selection with a subsequent process step.

27. The wizard creator of claim 20, wherein one of the potential selections permits input of a character string.

28. The wizard creator of claim 20, wherein the user interface prompts input of a query as a process step.

29. The wizard creator of claim 28, wherein the user interface prompts input of potential answers to a query as associated potential selections.

30. The wizard creator of claim 20, wherein the memory is further adapted to store the created wizard.

31. The wizard creator of claim 20, wherein at least one of a stored process step and potential selection in the created wizard is modifiable through the user interface.

32. The wizard creator of claim 20, wherein the user interface further prompts input of a designation, associated with a process step, indicating one of machine and non-machine processing.

33. The wizard creator of claim 32, wherein the user interface further prompts input of information relating to the machine processing upon receiving an input of a designation indicating machine processing.

34. The wizard creator of claim 33, wherein the user interface further prompts input of a machine connection.

35. The wizard creator of claim 34, wherein the input of the machine connection includes input of a URL.

36. An article of manufacture, comprising:

a computer usable medium including,

first code for causing a computer to prompt input of process steps and a plurality of potential selections associated with each of the process steps;

second code for causing a computer to store input process steps and associated potential selections; and

third code for causing a computer to create a wizard based upon the stored process steps and associated potential selections.

37. The article of manufacture of claim 36, wherein the first code causes the computer to prompt via a displayed template.

38. The article of manufacture of claim 36, wherein the first code causes the computer to audibly prompt.

39. The article of manufacture of claim 36, wherein the first code and second code respectively cause the computer to further prompt and store an input designation, associating a potential selection with a subsequent process step.

40. The article of manufacture of claim 36, wherein the first code causes the computer to prompt input of queries as the process steps.

41. The article of manufacture of claim 40, wherein the first code causes the computer to prompt input of potential answers to the queries as the associated potential selections.

42. The article of manufacture of claim 36, wherein the first code and second code respectively cause the computer to prompt and store an input designation, associated with a process step, indicating one of machine and non-machine processing.

43. The article of manufacture of claim 42, wherein the first and second code respectively cause the computer to prompt and store input of information relating to the machine processing upon receiving an input of a designation indicating machine processing.

44. A propagated signal, comprising:

first code segment instructing prompting input of process steps and a plurality of potential selections associated with each of the process steps;

second code segment instructing storage of input process steps and associated potential selections; and

third code segment instructing creation of a wizard based upon stored process steps and associated potential selections.

45. The propagated signal of claim 44, wherein the propagated signal is embodied in a digital signal.

46. The propagated signal of claim 44, wherein the propagated signal is embodied in a digital bit stream.

47. The propagated signal of claim 44, wherein the propagated signal is embodied in a carrier wave.

48. The propagated signal of claim 44, wherein the first code segment instructs prompting via a displayed template.

49. The propagated signal of claim 44, wherein the first code segment instructs audible prompting.

50. The propagated signal of claim 44, wherein the first and second code segment respectively instruct prompting of input and storage of an input designation, associating a potential selection with a subsequent process step.

51. The propagated signal of claim 44, wherein the first code segment instructs prompting of input of queries as process steps.

52. The propagated signal of claim 51, wherein the first code segment instructs prompting of input of potential answers to the queries as the associated potential selections.

53. The propagated signal of claim 44, wherein the first code segment and second code segment respectfully instruct prompting of input and storage of an input designation, associated with a process step, and indicating one of machine and non-machine processing.

54. The propagated signal of claim 53, wherein the first and second code segments respectively instruct prompting of input and storage of input of information relating to the machine processing in response to receiving input of a designation indicating machine processing.

55. **(Cancelled)**

56. **(Cancelled)**

57. The method of claim 1, further comprising:

accessing prestored information and creating the wizard, at least in part, based upon the prestored information.

58. The method of claim 57, wherein the prestored information is stored in a relational database.

59. The method of claim 13, further comprising:

accessing prestored information upon receiving an input designation indicating machine processing.

60. The method of claim 59, wherein the prestored information is stored in a relational database.

61. The method of claim 1, further comprising:

storing additional information associated with at least one of a process step and potential selection.

62. The method of claim 58, wherein the additional information includes a URL.

63. The method of claim 57, wherein the prestored information includes information stored in a text file including a state table.

64. The method of claim 60, wherein the prestored information includes information stored in a text file including a state transition table.

65. The method of claim 1, further comprising:

selecting from a plurality of languages in which prompting will occur.